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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,554	12/17/2001	Thomas Maciag	54474-5005	3856

28977 7590 06/01/2004

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EXAMINER

ANGELL, JON E

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 06/01/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,554

Applicant(s)

MACIAG ET AL.

Examiner

Liping Chen

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, and 27, drawn to an isolated nucleic acid encoding a fibroblast growth factor-1 resistant to thrombin degradation, wherein the nucleic acid comprises the sequence of SEQ ID NO:3, or the nucleic acid comprises the sequence of SEQ ID NO:1 with mutation at position of 443 to 445, a vector, and a recombinant cells, and a composition comprising an isolated nucleic acid comprising the sequence of SEQ ID NO:3, or a fragment, or derivative thereof, classified in 435, subclass 320.1 or 325 or class 514, subclass 44.
- II. Claims 18 and 19, drawn to a transgenic non-human mammal comprising the isolate nucleic acid of claim 1 or claim 5, classified in class 800, subclass 8+.
- III. Claims 20-26, 28, 33-36 and 42-44, drawn to an isolated polypeptide comprising the amino acid sequence of SEQ ID NO:4, FGF-1_{R136K}, or a fragment, or derivative thereof, and a composition, classified in 530, subclass 350+ or 300 or class 514, subclass 12.
- IV. Claims 29-32, drawn to an antibody that specifically binds with a polypeptide comprising the amino acid sequence of SEQ ID NO:4, or fragment, or derivative thereof, and a composition comprising the antibody, classified in class 424, subclass 130.1.

In addition, upon the election of group IV, further election of the following patentably distinct species of the claimed invention is required:

Myocardial ischemia, peripheral vascular disease, cerebral ischemia, epithelial injury, epidermal wound injury, nerve injury, or bone damage.

The species of diseases are distinct because they have different cause, different in cell type, need different targeting and treatment.

The inventions are distinct, each from the other because:

Groups I-IV are distinct from each other because they are drawn to compositions having different chemical structures, physical properties and biological functions: isolated nucleic acid comprising the sequence of SEQ ID NO:3, or SEQ ID NO:1 with mutation at position of 443 to 445, or transgenic non-human mammal, isolated polypeptide comprising SEQ ID NO:4, a composition comprising an isolated polypeptide, or an antibody, respectively. The classification for each group is different. Search for each group does not require search for any other groups, and vice versa. Since the classification for each is different, the search for each group would not be coextensive. They are not obvious variants and deemed patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification,

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because of their recognized divergent subject matter, and the search required for any group is not required for remaining groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).)


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liping Chen, whose telephone number is (703) 305-4842. The examiner can normally be reached on Monday through Friday from 8:00 to 5:00 (Eastern Standard Time). Should the examiner be unavailable, inquiries should be directed to Deborah Reynolds, Supervisory Primary Examiner of Art Unit 1632, at (703) 305-4051. Any administrative or procedural questions should be directed to Pauline Farrier, Patent Analyst, at (703) 305-3550. Papers

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related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 308-8724.

Liping Chen, Ph.D.
Patent Examiner
Group 1632


DEBORAH J. REYNOLDS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600